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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PEREZ, JULIO R

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 09/12/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/754,212

Applicant(s)

RICARD ET AL.

Examiner

Julio R Perez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 05, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-10 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/5/01 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a) because they fail to show reference 2 on Figure 1 as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 7 recites the limitation "said threshold value" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 1-4, 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Raffel et al. (5,675,629).

Regarding claims 1 and 2, Raffel et al. clearly show a mobile station 12 on Figure 1 that communicates with both a cellular network 16 and to a cordless cellular base station 10 (column 2; line 26-30). Raffel et al. mobile station (terminal) 12 also includes communication means for communicating with both a conventional regional cellular base station and to the cordless base station utilizing the same cellular frequency range and communications protocol as specified (column 2; lines 35-39). Raffel et al. further disclose one preferred method of controlling (commanding) a base station that comprises the steps initially registered with the cellular network, registering the mobile telephone (station) 12 to receive telephone service through the base station upon being detected by the mobile telephone (station), wherein the mobile telephone (station), while operating in a cellular environment, detects the base station using the base station operating power levels (power thresholds) in order to recognize locations that are within the base station vicinity, herein triggering the search for the base station using stored (programmed) base station identification information when in proximity to the base station, wherein the mobile (station) automatically disengages (de-registers) from the cellular network upon detecting the mobile station, consequently receiving confirmation that the mobile telephone 12 has automatically switched from providing cellular service to the providing cordless landline service (column 3; lines 25-45).

Regarding claim 3, Raffel et al. disclose the means of controlling a base station to include the commands of receiving a mobile station identification number from the

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mobile telephone 12, wherein comparing the received mobile station identification numbers stored in the base station, wherein the mobile station identification numbers of the list each corresponds to mobile stations registered with the base station, consequently processing communications from the mobile telephone in response to a match between the received mobile station ID number and an entry of the list resulting from the comparison (column 3; lines 60-67 and column 4; 1-17).

Regarding claim 4, Raffel et al. further disclose means of avoiding transmitting on a frequency already in use nearby the public or private cellular network 16 or by the cordless cellular base stations 18 means of using interference score measurements; that is, by using appropriate channel abandonment thresholds; the cordless cellular base station 10 randomly selects for its backup frequencies, a specified number of downlink frequencies whose scores are below a high threshold value (Ht), Figure 21 (column 6, 28-36).

Regarding claim 8, Raffel et al. further disclose that by communicating with the cellular network 16, the cordless cellular base station 10 is favorably able to inform the cellular network 16 where to route telephone calls for the mobile station's identification number when the mobile is registered with the cordless cellular base station 10 ensuring that the mobile station user will always receive telephone calls regardless of the mode of operation of the mobile station 12 (column 4; 58-65).

Regarding claim 9, Raffel et al. disclose that in the preferred embodiment, per registration privileges with a particular cordless cellular base station 10, the mobile 12

automatically registers with the cordless cellular base station 10 when the mobile station 12 comes in proximity with the cordless cellular base station 10 (column 3; 32-36).

Regarding claim 10, Raffel et al. disclose switching means to a cordless cellular base station 10 when the mobile station 12 comes within the range of a cordless cellular base station 10 with which it has previously registered, in accordance with the preferred embodiment, it, in turn, automatically switches from regional cellular service mode to cordless telephone landline service mode without user intervention (column 4, 17-23).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Raffel et al. (Raffel) in view of Madhavapeddy et al. (5875400) (Madhavapeddy).

Regarding claim 5, Raffel teaches the claim invention, that is, the cordless cellular base station 10 is not operational without the network authorization, as the cellular network 16 provides the cordless cellular base station 10 with certain operating parameters, such as a list of authorized frequencies for its operation (consequently, the terminal 12 would no be operational as well) (column 3; lines 25-30). But Raffel does not explicitly disclose the storing of frequencies used. Raffel discloses that the mobile stations 12 are allowed to register with the cordless cellular base stations 10, after the

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cellular network has provided the list of authorized operational frequencies (column 3; lines 26-29).

However, the preceding limitation is known in the art of communications. Madhavapeddy discloses the use of storing the frequencies of the network, that is, the information relating to the mobiles 10a, 10b within the service area of the mobile switching center 14 is stored in a visitor location register or database 16 associated with the switching center (column 2; lines 43-46). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to improve Raffel's authorized frequencies of operation as taught by Raffel by implementing storing of the network frequencies used by the terminal, because it would provide Raffel's cordless cellular system with the enhanced capability of frequency storage in a visitor location register or database 16 as taught by Madhavapeddy.

Allowable Subject Matter

9. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter: The priority art teaches a registration of the cordless cellular base station with the cellular network before enabling its operation.

On the other hand, the applicant teaches means for calculating the probability of use of each network by the terminal and wherein the triggering event for a local network is the crossing of a probability threshold for use of that network, as recited in claim 6.

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This limitation, in conjunction with all limitations of the independent and dependent claim, respectively, has not been disclosed, taught, or made obvious over the prior art of record.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the art with respect to mobile telecommunications terminals for use with a cellular and in a preferred local cordless network.

Us Pat. NO. 5,675,629 to Zicker,	Multi-mode communication network with handset/cordless base station.
Us Pat. NO. 5,920,815 to Akhavan,	Personal phone number system.
Us Pat. NO. 6,226,527 to Dalsgaard et al.,	Intelligent Network Searching for a Multi-mode Phone.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julio R Perez whose telephone number is (703) 305-8637. The examiner can normally be reached on 7:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh N Tran can be reached on (703) 305-4040. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

JRP
September 4, 2003


SINH TRAN
PRIMARY EXAMINER